

**AMENDMENTS TO THE DRAWINGS**

The drawings were objected to under 37 C.F.R. § 1.83(a) because they allegedly fail to show proper elements of Figure 1 and Figure 2 as described in the specification.

The Applicant points out that the present application was inadvertently filed with incorrect Figures 1a-1e and 2. The Applicant has now cancelled originally submitted FIGS. 1a-2 and is hereby submitting Replacement Sheets of FIGS. 1-2. The Applicant points out that paragraphs 30-59 of the specification fully describe and support the currently submitted Replacement Sheets of Figures 1 and 2. Furthermore, **the Examiner is referred to MPEP 608, which states, in relevant part, that “all amendments or claims must find descriptive basis in the original disclosure, or they involve new matter.”** Since paragraphs 30-59 of the specification fully describe and support the currently submitted Replacement Sheets of Figures 1 and 2, the Applicant submits that no new matter has been introduced by the Replacement Sheets.

### **REMARKS / ARGUMENTS**

The present application includes pending claims 1-31, all of which have been rejected. By this Amendment, claims 1-2, 6-12, 16-21, and 27 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

The Examiner asserts that the listing of references in the specification is not a proper information disclosure statement, and therefore they have not been considered.

The specification is objected to because of formalities. The Applicant has amended the specified paragraphs in order to overcome this objection.

Claims 1-5, 8-15, 18-25, and 28-31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2002/0104099, issued to Novak (hereinafter, Novak). Claims 6, 7, 16, 17, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak, in view of U.S. Patent No. 7,174,512, issued to Martin, et al. (hereinafter, Martin). The Applicant respectfully traverses these rejections at least based on the following remarks.

#### **I. Information Disclosure Statement**

The Examiner asserts that “the listing of references in the specification is not a proper information disclosure statement, and therefore they have not been considered.”

The Applicant points out that it is believed that none of the references cited in the cross-reference section (or any other section that incorporates an application by reference) of the present application qualify as prior art to the

present application. In instances where a cross-reference section was used (or any other section which incorporates an application by reference), the Applicant points out that the Examiner was simply being notified of applications that may be considered related to the present application (e.g., including at least one common inventor and/or a common disclosure with the present application). Therefore, it is believed that none of the references cited in the cross-reference section (or in any other section that incorporates by reference) need be cited in an IDS.

## **II. Drawings**

The drawings were objected to under 37 C.F.R. § 1.83(a) because they allegedly fail to show proper elements of Figure 1 and Figure 2 as described in the specification.

The Applicant points out that the present application was inadvertently filed with incorrect Figures 1a-1e and 2. The Applicant has now cancelled originally submitted FIGS. 1a-2 and is hereby submitting Replacement Sheets of FIGS. 1-2. The Applicant points out that paragraphs 30-59 of the specification fully describe and support the currently submitted Replacement Sheets of Figures 1 and 2. Furthermore, **the Examiner is referred to MPEP 608, which states, in relevant part, that “all amendments or claims must find descriptive basis in the original disclosure, or they involve new matter.”** Since paragraphs 30-59 of

the specification fully describe and support the currently submitted Replacement Sheets of Figures 1 and 2, the Applicant submits that no new matter has been introduced by the Replacement Sheets.

### **III. Specification**

The Applicant has amended paragraphs 0002 and 0039, as set forth above, to overcome the objections to the specification. The Applicant submits that the objection to the specification should now be withdrawn.

### **REJECTION UNDER 35 U.S.C. § 102**

#### **IV. Novak Does Not Anticipate Claims 1-5, 8-15, 18-25, and 28-31**

The Applicant now turns to the rejection of claims 1-5, 8-15, 18-25, and 28-31 under 35 U.S.C. 102(e) as being anticipated by Novak. With regard to the anticipation rejections under 102(e), MPEP 2131 states that "[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See id. (internal citation omitted).

*Without conceding that Novak qualifies as prior art under 35 U.S.C. 102(e), the Applicant respectfully traverses this rejection as follows.*

**A. Rejection of Independent Claim 1 under 35 U.S.C. § 102(e)**

With regard to the rejection of independent claim 1 under 102(e), the Applicant submits that Novak does not disclose or suggest at least the limitation of "organizing, at said first location, said located media and at least a portion of broadcast media and/or transferred media into channels," as recited by the Applicant in independent claim 1.

The Office Action states:

With respect to Claim 1, the claimed "locating media stored locally at least at a first location in the communication network; organizing said located media into channels" is met by Novak teaching an upload source 122 sending media files to a local studio 106 and having control as to their scheduling in a 'synthetic' channel (Fig.1 & 4; paragraphs 0010, 0026, 0041, 0056, &0057). The claimed "transparently transferring at least a portion of said organized channels to at least a second location within the communication network" is met by Novak teaching a user at a second location 152 receiving media files associated with the 'synthetic' channel when it is selected for viewing (Fig. 4 & 11; paragraphs 0059, 0085, & 0086).

See the Office Action at page 5. Referring to FIG. 1 of Novak, the Applicant points out that the upload source 122 can upload media to the web site or server 124. See Novak at ¶¶ 0040-0041. In addition, the uploaded media may include

personal media, as described in more detail in ¶ 0039 of Novak. However, the media uploaded to server 124 does not include any television broadcast channel type media. As seen from Novak's FIG. 1, such broadcast media is provided separately by the cable service provider 108 over the cable network 134. In this regard, Novak does not disclose or suggest at least the limitation of "organizing, at said first location, said located media and at least a portion of broadcast media and/or transferred media into channels," as recited by the Applicant in independent claim 1.

Referring to FIG. 4 of Novak, the Applicant also points out that at step 406, that a token or electronic file is sent to the end user to subscribe the end user's terminal (set top box 152) to the synthetic channel. In this regard, Novak also does not disclose that at least a portion of the channel itself is transparently transferred to at least a second location within the communication network, as recited in Applicant's claim 1. Furthermore, the Applicant submits that the fact that a token or an electronic file is transferred to effectuate subscription to the synthetic channel illustrates that the transfer of information is not transparent.

Accordingly, independent claim 1 is not anticipated by Novak and is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that

independent claims 11 and 21 are also allowable over the reference cited in the Office Action at least for the reasons stated above with regard to claim 1.

**B. Rejection of Dependent Claims 2-5, 8-10, 12-15, 18-20, 22-25, and 28-31**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(e) as being anticipated by Novak has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-5, 8-10, 12-15, 18-20, 22-25, and 28-31 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-5, 8-10, 12-15, 18-20, 22-25, and 28-31.

**REJECTION UNDER 35 U.S.C. § 103**

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of



success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

**V. The Proposed Combination of Novak and Martin Does Not Render Claims 6, 7, 16, 17, 26, and 27 Unpatentable**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(e) as being anticipated by Novak has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Martin) does not overcome the deficiencies of Novak, claims 6, 7, 16, 17, 26, and 27 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 6, 7, 16, 17, 26, and 27.

**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-31 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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